

REMARKS

Claims 1-3, 5-17, 19-32, 34-47, 49-61 and 63-71 were pending and appealed. The examiner was reversed on appeal as to the rejection of claims 29-32, 34-47, 49-61 and 63-67. Among the rejected claims, applicants have cancelled claims 1-3, 5-17 and 19-28, without prejudice or disclaimer. Applicants have amended claims 68 and 71 in view of the reasoning of the appeal decision. More specifically, both claims 68 and 71 have been revised to prescribe that direct injection is used for transfecting particulate polynucleotide or DNA fragment to an antigen presenting cell. Applicants also have revised claim 68 to prescribe that the expressed antigen, in an antigen presenting cell, elicits an anti-tumor or anti-viral immune response in a host that destroys neoplastic or virally infected cells. In addition, claims 32, 47 and 64 have been revised to find a proper antecedent basis from their independent claims.

Claims 72-112 added here are dependent on claim 29, 44, 59, 68 or 71. Support for the new claims can be found throughout the specification, for example, at page 6, line 27 to page 7, line 1, and original claims. Upon entry of the amendment as indicated above, claims 29-32, 34-47, 49-61 and 63-112 will be pending in this case.

The following remarks are offered to show that amended claims 68 and 71 are allowable in view of the appeal decision.

With respect to claims 68-71, the Board of Patent Appeals and Interferences (BPAI) has affirmed the following examiner's rejections:

- (1) Rejection of claims 68 and 69 under 35 U.S.C. §102(b) as anticipated by Tang or Barry '94;
- (2) Rejection of claims 68-70 under 35 U.S.C. §102(b) as anticipated by Hui; and
- (3) Rejection of claims 68-71 under 35 U.S.C. §103 as obvious over Weiner in view of either Tang or Barry '94.

In affirming the Rejection (1), the BPAI reasons at page 10 that "unlike claims 1, 15, 29 and 71, there is no requirement in claim 68 that the transformed APC stimulate

an immune response capable of eliciting an anti-tumor or anti-viral immune response in said host that destroys neoplastic or virally infected cells".

Following the reasoning of the BPAI, applicants have revised claim 68 to prescribe that the expressed antigen in an antigen presenting cell elicits an anti-tumor or anti-viral immune response in a host that destroys neoplastic or virally infected cells. The BPAI held that such feature of the expressed antigen is not inherently disclosed either Tang or Barry '94. Thus, applicants respectfully request reconsideration and withdrawal of the rejection (1) in view of the appeal decision and the amendment of claim 68.

With respect to the Rejection (2), the BPAI differentiates claim 68 from claims 1, 15, 29 and 71, noting the absence of requirement in claim 68 that a response be obtained in a mammalian host.

Applicants would draw the examiner's attention to amended claim 68, which further recites "direct injection" for delivering a particulate polynucleotide. As discussed at pages 13-14 in the appeal decision, the BPAI found error in the examiner interpretation that the term "direct injection" of the claimed invention encompasses using both using a gene gun as well as direct injection without use of a gene gun. Based on this finding, the BPAI held that claim 29 that requires "direct injection" for inoculation is not anticipated by Hui that teaches the use of biolistic delivery only. Therefore, in applying the same reasoning to the amended claim 68, applicants respectfully submit that Hui does not qualify as an anticipatory reference against claim 68. Accordingly, reconsideration and withdrawal of the Rejection (2) are respectfully requested.

The BPAI affirmed the Rejection (3) based on the grounds that claims 68-71 are generic to the method for transfecting an antigen presenting cell, unlike claims 29, 44 and 59 that are limited to direct injection. Keeping this reasoning in mind, applicants have revised claims 68 and 71 as a method that uses direct injection for transfecting an antigen presenting cell. In view of this amendment, therefore, applicants respectfully request reconsideration and withdrawal of the Rejection (3).

In view of the foregoing amendment and remarks, applicants respectfully request favorable reconsideration and allowance of the pending claims. If there are any issues remaining which the examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the examiner hereby respectfully invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date 28 March 2003

By S. A. Bent

FOLEY & LARDNER  
Washington Harbour  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007-5109  
Telephone: (202) 672-5404  
Facsimile: (202) 672-5399

Stephen A. Bent  
Attorney for Applicants  
Registration No. 29,768